

Beiersdorf 454.4-KGB/HCL
100718-53
6713-Dr. Wi-ar

REMARKS

Status of claims

Claims 4-8 are now pending. No amendments have been made; the claims have been reproduced for convenience.

35 U.S.C. § 103(a) rejection

Claims 4-8 remain rejected over Allard et al. (U.S. Patent 5,616,331 - hereafter referred to as "Allard"). Since the applicants' response of 26 February 2002, the applicants and the Examiner have essentially maintained their current positions, i.e. the applicants assert that Allard does not teach a microemulsion whereas the Examiner asserts that either Allard teaches a microemulsion or that a microemulsion can easily be obtained by modifying the conditions disclosed in Allard's ultrafine emulsions.

It is well known that "[t]he ultimate determination of whether an invention would have been obvious under 35 U.S.C. § 103(a) is a legal conclusion based on underlying findings of fact." *In re Kotzab*, 217 F.3d 1365, 1369, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000).

The applicants have provided evidence in support of their position during prosecution as follows:
applicants' response of 26 February 2003

- (1) *Emulsions and Emulsion Technology (part III)*, Marcel Dekker, Inc., page 143, (1984).
- (2) Microemulsions: A Definition (Surfactants Virtual Library - <http://surfactants.net/microemulsion>), (2002).

applicants' response of 4 August 2003 (resubmitted on 24 September 2003)

- (3) "Surfactants, Micelles, Liposomes and Liquid Crystals in Emulsions and Microemulsions", ACS Short Course, May 6th - May 10th, 2002 (page 19 of course material).

Thus far, the Examiner has not provided any other evidence beyond the reliance on Allard to support their position that the ultrafine emulsions of Allard are the same or render obvious the applicants claimed microemulsions.

While it is believed that the record thus far is sufficient to establish that there is a preponderance of

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evidence ("more likely than not" - see MPEP 2142) that the applicants' claims are unobvious over the Allard reference, the applicants present with this preliminary amendment a declaration under Rule 1.132 by Dr. Yuzhuo Li of Clarkson University.

Dr. Li is **not an inventor** of this application and has no pecuniary interest in the application or patent that may issue therefrom. He has done extensive work in the field of emulsion chemistry and is eminently qualified to comment on the question before us.

Dr. Li confirms that Allard does not teach an ultrafine emulsion (see page 2, paragraph 1. and 1a.) and proceeds to describe how determination of whether an emulsion is a microemulsion cannot be reduced to similarities of a single property (such as particle size as is being asserted by the Examiner) but that it is a bundle of properties which must be considered. Moreover, Allard's inclusion of pigments such as TiO_2 teaches away from any suggestion that Allard intended or thought it to be possible that his ultrafine emulsions could be "optimized" to produce a microemulsion.

For each of the above reasons, the applicants believe that the factual burden required to establish *prima facie* obviousness has not been met and that the Examiner would be fully justified in allowing the present claims.

Closing

Applicants also believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,
Norris, McLaughlin & Marcus, P.A.

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Attachment: Declaration under 37 CFR 1.132 by Dr. Yuzhuo Li

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Preliminary Amendment (6 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: 23 July 2004

By: Agata Glińska
Agata Glińska